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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,445	07/03/2003	Thomas E. Nahill	18161 USA	6518
27081	7590	01/11/2005		
OWENS-ILLINOIS, INC. ONE SEAGATE, 25-LDP TOLEDO, OH 43666			EXAMINER RAYFORD, SANDRA M	
			ART UNIT	PAPER NUMBER

1772

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,445

Applicant(s)

NAHILL ET AL.

Examiner

Sandra M. Nolan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-18-04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Two title abstracts</u> . |

DETAILED ACTION

Claims

1. Claims 3-10 are pending. Claims 1-2 have been cancelled.

Withdrawal of Allowance

2. The allowance of claims 3-10, as stated in section 6 of the 15 September 2004 office action ("the last office action"), is withdrawn in order to apply the new grounds of rejection below.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 18 October 2004 was considered by the examiner.

Rejection Rendered Moot

4. The 35 USC 103 rejection of claims 1-2 as unpatentable over Larsen (US-2004/0146673) in view of Slat (US 6,413,600), as set out in section 5 of the last office action, has been rendered moot by the cancellation of claims 1-2 in the response dated 18 October 2004.

New Rejections

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valyi (US 5,884,786) in view of Tsukada (US 4,591,060).

Valyi teaches a blow-molding (title) preform **10** having a flange **20** at its open end and a threaded finish **14** adjacent the flange (Figures 1 and 2; col. 2, line 55 through col. 3, line 9). The finish is kept from moving axially by expansion of the preform under flange **22** (col. 4, lines 23-25). Also, bead **56** may be formed during the container's molding (Figure 4; col. 4, lines 25-29).

The area adjacent the flange is deemed to be the neck of the preform.

Valyi fails to teach the crystallization of the neck.

Tsukada teaches the crystallization of the neck of a blow molded container (abstract) in order to secure tightening of the cap thereon (col. 2, lines 34-44) and to stabilize the neck section physically (col. 4, lines 37-43).

The patents are analogous because both deal with blow molded containers.

It would have been obvious to one having ordinary skill in the art at the time of the invention to perform the crystallization operation of Tsukada on the necks of the Valyi preforms in order to strengthen them.

The motivation to perform the crystallization operation of Tsukada on the necks of the Valyi performs is found at col. 2, lines 34-44 and at col. 4, lines 37-43 of Tsukada, where crystallization is said to facilitate tightening of caps on the necks and to enhance the physical stability of the performs.

It is deemed desirable to facilitate tightening of caps on the necks and to enhance the physical stability of the performs in order to make the make the production and filling of the containers easier.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 3-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/351,671 (as published in US 2004/0146673A1; "the '673 publication") in view of Valyi and Tsukada.

US SN. 10/351,671 and this application have no common inventor, but they are commonly assigned. See the title abstracts on the enclosed sheets.

This is a provisional obviousness-type double patenting rejection.

The '673 publication claims preforms and processes in which the neck of a the preform is partially crystallized. It fails to claim expansion and crystallization of the neck.

Valyi and Tsukada are discussed above.

The three references are analogous because they all deal with performs.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the expansion and crystallization operations of Valyi and Tsukada when making the performs of the '673 publication in order to gain the resistance to axial movement of the ring discussed by Valyi and the strength properties attributable to crystallized necks by Tsukada.

The motivation to employ the expansion step of Valyi when making the performs of the '673 publication is found at col. 4, lines 23-25 of Valyi, where the axial movement of the ring is said to be prevented by the expansion of the preform in the area adjacent the flange.

The motivation to employ the crystallization operation of Tsukada when making the performs of the '673 publication is found at col. 4, lines 37-44 of Tsukada, where the strength of the preform's neck is said to improved by crystallizing it.

It is deemed desirable to firmly position the ring on the neck of the preform and to strengthen the neck in order to make container production more efficient.

10. Claims 3-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of

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copending Application No. 10/375737 (published as US 2004/0166264A1; "the 264 publication") in view of Tsukada.

This is a provisional obviousness-type double patenting rejection.

The claims of the '264 publication cover processes, containers and preforms featuring preforms with finish rings attached thereto, which preforms are expanded before or after containers are made therefrom.

They fail to recited the crystallizing of the neck of the preforms.

Tsukada is discussed above.

The references are analogous because they both deal with preforms for making blow molded containers.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ crystallization operations Tsukada when making the performs of the '264 publication in order to strengthen the necks.

The motivation to employ the crystallization operation of Tsukada when making the performs of the '264 publication is found at col. 4, lines 37-44 of Tsukada, where the strength of the preform's neck is said to improved by crystallizing it.

It is deemed desirable to strengthen the necks of preforms in order to facilitate the movement of the preforms during container production.

Citation as of Interest

11. US 6,811,845 to (Nahill et al, issued from US SN. 10/375,758) is cited of interest for teaching the crystallization of the finish ring before it is placed on the preform.

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Response to Arguments


12. Applicants presented no arguments with respect to claims 3-10 in the last response. Therefore, no responses are needed.

Conclusion

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.


S. M. Nolan-Rayford
Primary Examiner
Technology Center 1700

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